

AF/2642

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. AUS920010294US1

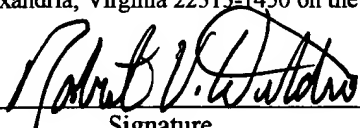
IN RE APPLICATION OF: §
§
Joseph Herbert McIntyre § Examiner: Hector A. Agdeppa
§
Serial Number: 09/826,663 § Art Unit: 2642
§
Filed: April 5, 2001 §
§
For: Selective Call Forwarding §
§
§

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is submitted in triplicate in support of the Appeal in
the above-identified application.

CERTIFICATE OF MAILING 37 CFR 1.8(a)	
I hereby certify that this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date below:	
<u>JANUARY 7, 2005</u> Date	 Signature

APPEAL BRIEF
PAGE 1 OF 16

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

44

45

TABLE OF CONTENTS

46

47 REAL PARTY IN INTEREST 4

48

49 RELATED APPEALS AND INTERFERENCES 4

50

51 STATUS OF CLAIMS 4

52

53 STATUS OF AMENDMENTS 4

54

55 SUMMARY OF THE INVENTION 5

56

57 ISSUES 6

58

59 GROUPING OF THE CLAIMS 7

60

61 ARGUMENT 7

62

63 I. With regard to the double patenting rejection of claims
64 1-35 based upon a co-pending application, it is respectfully
65 submitted that since the co-pending application (though not the
66 inventions contained therein) has been abandoned, this rejection
67 is now moot and should be withdrawn on the record.

68

69 II. With regard to the rejection of claims 1-35 under 35 USC
70 103(a) over Tatchell in view of Contractor, it is respectfully
71 submitted that there is no basis, disclosure, teaching or even
72 suggestion in the hypothetical combination of references
73 sufficient to render the present invention (as presented in
74 currently pending claims 1-35) obvious and that further, the
75 hypothetical combination of Tatchell and Contractor is not
76 suggested by either reference and therefore is an improper

APPEAL BRIEF

PAGE 2 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

77 combination for use in rejecting applicant's claims.
78

79 III. With regard to the improper consideration of mobile
80 phone features available at the time the Final Office Action was
81 mailed but which were not shown to be available at the time the
82 present invention was filed, it is submitted that even the
83 consideration of these features improperly biased the Examiner's
84 consideration on the issue of obviousness and that therefore the
85 obviousness rejection of claims 1-35 based upon an evaluation of
86 currently available mobile phone features not shown to have been
87 known at the time the present application was filed should be
88 withdrawn.
89
90

91 CONCLUSION 12
92

93 APPENDIX (Pending Claims) 14-20
94

APPEAL BRIEF
PAGE 3 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

95 REAL PARTY IN INTEREST

96
97 The present application is assigned to International Business
98 Machines Corporation, the real party in interest.
99

100
101 RELATED APPEALS AND INTERFERENCES

102
103 No related appeal is presently pending.
104
105

106 STATUS OF THE CLAIMS

107
108 Claims 1-35 are pending and stand finally rejected by the
109 Examiner as noted in the Final Office Action mailed August 11,
110 2004.
111

112 STATUS OF AMENDMENTS

113
114 Prior to the Final Office Action (mailed 8/11/04), there was only
115 one Office Action mailed 3/25/04 and one Amendment mailed
116 5/28/04. The Second and Final Office Action cited a new reference
117 and rejected all 35 claims under the judicially created doctrine
118 of double patenting over the claims of co-pending application No.
119 09/826,663 and also under 35 USC 103 over a combination of two
120 references, Tatchell and Contractor. The last entered amendment
121 was submitted 5/28/04 which amended the claims to the text shown
122 in the Appendix.

APPEAL BRIEF
PAGE 4 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

123 SUMMARY OF THE INVENTION

124
125 The present application discloses a method and implementing
126 system in which a user of a telephone call forwarding service is
127 enabled to designate selected callers and/or phone numbers which
128 the user wishes to have forwarded to a specified number which is
129 input by the user. In an exemplary embodiment, a user menu is
130 communicated to the user and the user is enabled to input a new
131 phone number to which the user wishes to have selected calls
132 forwarded. The user is further enabled to input the selected
133 caller names and/or phone numbers which are to be forwarded to
134 the new number, and all other calls are handled in accordance
135 with a predetermined process, such as, for example, voice mail.
136 (See "Summary of Invention", page 3 of the specification and,
137 *inter alia*, Fig. 6, 601-605 and Fig.7, 703, 705, 721-727.)

138
139 The above methodology is set forth in pending claim 1, which
140 recites:

141
142 "1. A method for enabling a forwarding of only selected incoming telephone calls from a first
143 number to a second number, said method comprising:
144
145 identifying selected phone numbers for incoming telephone calls to said first number which a user
146 wishes to have forwarded from said first number to said second number;
147
148 displaying said selected phone numbers on a user device;
149
150 enabling input of said second number to said user device;
151

152 displaying said second number on said user device; and

153
154 enabling said user to provide an input to accept said second number and said selected phone
155 numbers whereby only incoming telephone calls to said first number from said identified selected
156 phone numbers are transferred from said first number to said second number."

157
158
159 **ISSUES**

160
161 1. Is the double patenting rejection of claims 1-35 over the co-
162 pending application 09/826,663 still valid?

163
164 2. Is the Examiner's rejection of claims 1-35 under 35 USC 103(a)
165 as being unpatentable over Tatchell et al (U. S. Patent
166 6,160,877, hereinafter referred to as "Tatchell") in further view
167 of Contractor et al (US 2002/0085687, hereinafter referred to as
168 "Contractor") well founded, and is the hypothetical combination
169 of Tatchell and Contractor suggested by either reference??

170
171 3. Is it appropriate to consider features available on mobile
172 phones on the date of the Final Office Action, i.e. August 11,
173 2004, but not shown to have been available at the time the
174 present application was filed more than three years earlier on
175 April 5, 2001, and did even the consideration of those features
176 improperly influence the Examiner's understanding of what was
177 obvious at the time the present application was filed?

178
179
APPEAL BRIEF
PAGE 6 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

180 GROUPING OF THE CLAIMS

181
182 For purposes of this Appeal, claims 1-35 stand or fall together.
183
184

185 ARGUMENT

186
187 I. With regard to the rejection of claims 1-35 based on double
188 patenting over the co-pending application 09/826,663, it is noted
189 that the co-pending application (but not the invention contained
190 therein) has been expressly abandoned and the double patenting
191 rejection is no longer valid and should be withdrawn.
192

193 II. With regard to the rejection of claims 1-35 under 35 USC
194 103(a) over Tatchell in view of Contractor, it is respectfully
195 submitted that there is no basis, disclosure, teaching or even
196 suggestion in Tatchell or Contractor, or, therefore necessarily,
197 in a combination of both, which would be sufficient to render the
198 present invention (as presented in currently pending claims 1-35)
199 obvious. It is further submitted that even the hypothetical
200 combination of Tatchell and Contractor not only does not teach or
201 suggest the total combination of elements and relationships as
202 presently set forth in the appended claims, but in fact, both
203 Tatchell and Contractor actually teach away from the present
204 invention as currently defined by the claims, by requiring
205 audible interaction with mobile phones and not a manual text
206 input methodology and display screen for **inputting and displaying**
207 **selected calls for forwarding as well as inputting and displaying**
208 **a number to which the selected calls are to be forwarded as is**

209 done with the present invention.
210
211 Tatchell discloses a method of screening and prioritizing an
212 incoming call which is enabled by a subscriber using voice
213 commands. Tatchell does not disclose, teach or even suggest the
214 use of a visual display on a user device to enable entering and
215 confirming the numbers of incoming calls to be forwarded and the
216 forwarding number to which the incoming calls are sent. The
217 present invention overcomes the inaccuracies of audible input by
218 enabling a user to provide manual and visual call forwarding
219 input to a user device and to complete the input with a positive
220 key entry after visually confirming the input on a display
221 associated with the user device. The use of a user device having
222 a display capability would be directly against the teachings of
223 Tatchell so it cannot be said that it is obvious from Tatchell to
224 use a display device for entering call forwarding information. If
225 anything, Tatchell teaches away from the present invention by
226 disclosing only a voice-activated system and not mentioning even
227 a possible function in his system for a display device. Indeed,
228 it is submitted that the insertion of a display function in the
229 Tatchell system would render the Tatchell system inoperable for
230 its intended purpose. This is true of any audible input system
231 including the Contractor reference as well. It is the stated
232 objective of such audible systems to enable input without
233 distracting the user from other activities such as driving a
234 motor vehicle. The present invention requires the use of a
235 display screen and therefore is directly opposed to the
236 objectives of Tatchell and/or Contractor. It is noted that the

APPEAL BRIEF
PAGE 8 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

237 current claims include displaying selected phone numbers to be
238 forwarded on a user device, enabling input of a second or
239 forwarding number to the user device to which the selected phone
240 numbers are to be forwarded, displaying the second or forwarding
241 number on the user device and enabling the user to provide an
242 input to execute based upon a **visual confirmation of the accuracy**
243 **of both the user number input of a selected incoming call number**
244 **to be forwarded**, and the user number input indicating the number
245 to which the selected call is to be forwarded. Tatchell, at best,
246 teaches, in column 20 beginning on line 21, that a user can have
247 **all calls** forwarded to a given number but this is clearly
248 distinguishable from the present invention in which **only selected**
249 **incoming calls as designated and input by a user are forwarded to**
250 **designated and input forwarding numbers input by the user.**

251
252 Contractor teaches a system for intercepting an incoming call and
253 announcing information concerning the calling party before a user
254 a user accepts or rejects the incoming call. Contractor is
255 similar to Tatchell to the extent that neither Tatchell nor
256 Contractor (nor the combination of both) disclose the methodology
257 disclosed and claimed by the applicant, viz. displaying selected
258 phone numbers to be forwarded on a user device, enabling input of
259 a second or forwarding number to the user device to which the
260 selected phone numbers are to be forwarded, displaying the second
261 or forwarding number on the user device and enabling the user to
262 provide an input to execute the processing of the input
263 "received" and "forwarded to" numbers. Thus, even a hypothetical
264 combination of Tatchell and Contractor falls short of rendering

APPEAL BRIEF
PAGE 9 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

the present invention obvious since neither, or even both in combination, discloses the above noted claim features. Thus it is submitted that claims 1-35 as presented in the Appendix are allowable under 35 USC 103(a) over Tatchell and/or Contractor, or even both in combination.

It is further submitted that there is no suggestion in either Tatchell or Contractor for the hypothetical combination of Tatchell and Contractor and that such a combination would destroy each system for its respective intended purpose. Tatchell discloses a system in which a database is referred to in an immediate routing of incoming calls while the Contractor system suspends incoming calls while caller information is retrieved and the user is given the option whether to accept or reject the incoming call on a real time basis. There is no stated reason or suggestion in either reference that the two apparently diverging methodologies could be combined for any reason or of why it would be beneficial to combine the two references even if the two technologies were compatible for combination. It is therefore submitted that the hypothetical combination of Tatchell and Contractor is an improper combination of references and cannot be used as a basis to reject applicant's claims.

III. It is further submitted that applicant's claims were rejected based upon an improper consideration of current state-of-the-art features as applied to applicant's filing which was filed on 4/5/2001. In that regard, it is noted that the Examiner, on page 4 of the Final Office Action mailed 8/11/2004, stated

**APPEAL BRIEF
PAGE 10 OF 20**

293 that "I personally use an AT&T mobile telephone that allows
294 certain features to be applied to certain telephone numbers
295 wherein all of the interaction is done via visual displays and
296 entering inputs via the mobile phone keypad". From that
297 observation, the Examiner concludes that "Therefore, using
298 audible methods and visual methods are old and well known ...".
299 This observation of the Examiner's own mobile phone features
300 sometime before the 8/11/2004 mailing date of the Final Action is
301 apparently the sole basis (since no specific reference is cited
302 for this teaching) for the conclusion that audible methods of
303 input are an improvement upon visual manual input methods. This
304 is clearly not the case and it is submitted that even a
305 consideration of currently available mobile phone features (as is
306 established by the quoted text from the Office Action) is
307 improper and sufficient to unfairly bias and cloud the Examiner's
308 consideration of the obviousness issue. Thus, it is submitted
309 that even the consideration of current state-of-the-art features
310 of the mobile phone of the Examiner inappropriately biased the
311 Examiner's opinion regarding the non-obviousness of the present
312 invention and that therefore the obviousness rejection of claims
313 1-35 should be withdrawn, and that claims 1-35 are allowable
314 under 5 USC 103(a) over Tatchell in view of Contractor.

315
316
317
318
319
320
APPEAL BRIEF
PAGE 11 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

321 CONCLUSION

322
323 For the reasons stated above, applicant urges the Board to
324 consider that even the hypothetical combination of Tatchell and
325 Contractor does not even suggest much less render obvious, a
326 method or system including identifying selected phone numbers for
327 incoming telephone calls to a first number which a user wishes to
328 have forwarded from the first number to a second number,
329 displaying the selected phone numbers on a user device, enabling
330 input of a second number to the user device, displaying the
331 second number on the user device, and enabling the user to
332 provide an input to accept the second number and the selected
333 phone numbers whereby only incoming telephone calls to the first
334 number from the identified selected phone numbers are transferred
335 from the first number to the second number, as set forth in
336 claims 1-35 of the Appendix.

337
338 Consequently, applicant urges that the rejection of claims 1-35
339 under 35 USC 103(a) as being unpatentable over Tatchell in view
340 of Contractor, is not well-founded and should be reversed.

341
342 Please charge IBM Corporation Deposit Account No. 09-0447 in the
343 amount of \$500.00 for submission of a Brief in Support of Appeal.
344 No additional fee or extension of time is believed to be
345 required; however, in the event an additional fee or extension of
346 time is required, please charge the fee, as well as any other fee

347
348
APPEAL BRIEF
PAGE 12 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

349
350 necessary to further the prosecution of this application, to the
351 above-identified deposit account.

352

353

354 Respectfully submitted,

355

356

357

358

A handwritten signature in black ink, appearing to read "Robert V. Wilder", is written over a horizontal line.

359 Robert V. Wilder (Tel:512-246-8555)

360 Registration No. 26,352

361 Attorney at Law

362 4235 Kingsburg Drive

363 Round Rock, Texas 78681

364

365 ATTORNEY FOR APPLICANT

APPEAL BRIEF

PAGE 13 OF 20

Serial Number 09/826,663

Attorney Docket No. AUS920010294US1

APPENDIX

1. A method for enabling a forwarding of only selected incoming telephone calls from a first number to a second number, said method comprising:

identifying selected phone numbers for incoming telephone calls to said first number which a user wishes to have forwarded from said first number to said second number;

displaying said selected phone numbers on a user device;

enabling input of said second number to said user device;

displaying said second number on said user device; and

enabling said user to provide an input to accept said second number and said selected phone numbers whereby only incoming telephone calls to said first number from said identified selected phone numbers are transferred from said first number to said second number.

2. The method as set forth in claim 1 wherein incoming phone calls from phone numbers other than said selected phone numbers are processed by a default process.

3. The method as set forth in claim 2 wherein said default process is a voice mail system.

393 4. The method as set forth in claim 1 wherein said transferring
394 is accomplished by a server device.
395
396 5. The method as set forth in claim 4 wherein said identifying is
397 accomplished by a user remote from said server device.
398
399 6. The method as set forth in claim 5 wherein said identifying is
400 accomplished by a user inputting said selected phone numbers into
401 said user device and sending said selected phone numbers from
402 said user device to said server device.
403
404 7. The method as set forth in claim 5 wherein said identifying is
405 accomplished by a user relative to a selection menu displayed on
406 said user device.
407
408 8. The method as set forth in claim 7 wherein said selection menu
409 is stored in said user device.
410
411 9. The method as set forth in claim 7 wherein said selection menu
412 is stored in said server device, said server device being
413 selectively operable to effect a presentation of said selection
414 menu on said user device.
415
416 10. The method as set forth in claim 1 wherein said selected
417 phone numbers are selected from a file containing phone numbers
418 and names associated with said phone numbers.
419
420

APPEAL BRIEF
PAGE 15 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

421 11. The method as set forth in claim 10 wherein said selected
422 phone numbers are determined by designating only selected ones of
423 said phone numbers in said file.
424
425 12. The method as set forth in claim 5 wherein said user device
426 is a wireless device.
427
428 13. The method as set forth in claim 5 wherein said user device
429 includes input means for enabling said user to input said
430 selected phone numbers.
431
432 14. The method as set forth in claim 5 wherein said user device
433 is a cell phone.
434
435 15. The method as set forth in claim 5 wherein said user device
436 is a two-way pager device.
437
438 16. The method as set forth in claim 5 wherein said user device
439 is a computer device.
440
441 17. The method as set forth in claim 5 wherein said user device
442 is a laptop computer.
443
444 18. A storage medium including machine readable coded indicia,
445 said storage medium being selectively coupled through a reading
446 device to processing circuitry within a computing system, said
447 computing system being arranged to receive and re-direct incoming
448 telephone calls, said reading device being selectively operable

APPEAL BRIEF
PAGE 16 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

449 to read said machine readable coded indicia and provide program
450 signals representative thereof, said program signals being
451 effective to enable a forwarding of only selected ones of said
452 incoming telephone calls from a first number to a second number,
453 said program signals being further effective to accomplish the
454 steps of:

455
456 identifying selected phone numbers for incoming telephone calls
457 to said first number which a user wishes to have forwarded from
458 said first number to said second number;
459
460 displaying said selected phone numbers on a user device;
461
462 enabling input of said second number to said user device;
463
464 displaying said second number on said user device; and
465
466 enabling said user to provide an input to accept said second
467 number and said selected phone numbers whereby only incoming
468 telephone calls to said first number from said identified
469 selected phone numbers are transferred from said first number to
470 said second number.

471
472 19. The medium as set forth in claim 18 wherein incoming phone
473 calls from phone numbers other than said selected phone numbers
474 are processed by a default process.

477 20. The medium as set forth in claim 19 wherein said default
478 process is a voice mail system.
479
480 21. The medium as set forth in claim 18 wherein said transferring
481 is accomplished by a server device.
482
483 22. The medium as set forth in claim 21 wherein said identifying
484 is accomplished by a user remote from said server device.
485
486 23. The medium as set forth in claim 22 wherein said identifying
487 is accomplished by a user inputting said selected phone numbers
488 into a user device and sending said selected phone numbers from
489 said user device to said server device.
490
491 24. The medium as set forth in claim 22 wherein said identifying
492 is accomplished by a user relative to a selection menu displayed
493 on said user device.
494
495 25. The medium as set forth in claim 24 wherein said selection
496 menu is stored in said user device.
497
498 26. The medium as set forth in claim 24 wherein said selection
499 menu is stored in said server device, said server device being
500 selectively operable to effect a presentation of said selection
501 menu on said user device.
502
503
504

APPEAL BRIEF
PAGE 18 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

505 27. The medium as set forth in claim 18 wherein said selected
506 phone numbers are selected from a file containing phone numbers
507 and names associated with said phone numbers.
508

509 28. The medium as set forth in claim 27 wherein said selected
510 phone numbers are determined by designating only selected ones of
511 said phone numbers in said file.
512

513 29. A processing system including a system bus, and a processor,
514 a memory system, and a network interface, all coupled to said
515 system bus, said processing system being arranged to receive and
516 re-direct incoming telephone calls, said processing system being
517 operable to enable a forwarding of only selected ones of said
518 incoming telephone calls from a first number to a second number
519 by enabling a user of a user device to identify, on a display
520 associated with said user device, selected phone numbers for
521 incoming telephone calls which said user wishes to have forwarded
522 from said first number to said second number,
523 said processing system being operable for displaying said
524 selected phone numbers on said user device and enabling input of
525 said second number to said user device, said processing system
526 being further operable for displaying said second number on said
527 display of said user device and enabling said user to provide an
528 input to accept said second number and said selected phone
529 numbers whereby only incoming telephone calls to said first
530 number from said identified selected phone numbers are
531 transferred from said first number to said second number.
532

APPEAL BRIEF
PAGE 19 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1

533 30. The processing system as set forth in claim 29 wherein said
534 user device is a wireless device.
535
536 31. The processing system as set forth in claim 29 wherein said
537 user device includes input means for enabling said user to input
538 said selected phone numbers.
539
540 32. The processing system as set forth in claim 29 wherein said
541 user device is a cell phone.
542
543 33. The processing system as set forth in claim 29 wherein said
544 user device is a two-way pager device.
545
546 34. The processing system as set forth in claim 29 wherein said
547 user device is a computer device.
548
549 35. The processing system as set forth in claim 29 wherein said
550 user device is a laptop computer.

APPEAL BRIEF
PAGE 20 OF 20

Serial Number 09/826,663
Attorney Docket No. AUS920010294US1